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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/062,602	01/31/2002	Cristian Libanati	W9490-02	3426

7590

06/27/2003

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EXAMINER

ROSE, SHEP K

ART UNIT

PAPER NUMBER

1614

DATE MAILED: 06/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/062602

Applicant(s)

LIB ANATLEY

Examiner

SHAP ROSE

Group Art Unit

1614

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1217 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 1217 are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

Claims 1 to 8 and 13 to 17 are withdrawn, Rule 142(B) as non-elected subject matter. Dentifrices, claims 6 to 12 are elected, with traverse.

Claims 6 to 12 are generic to a plurality of disclosed patentably distinct species comprising

One ultimate disclosed species of:

(a) A second silica abrasive selected from one recited in claim 10, another silica gel, abrasive or a precipitated silica., OR LESS, ONLY ONE SILICA ABRASIVE:

(b) one "consists essentially of" amorphous silica gel silica abrasive as recited in claim 7

The difference between claim 7 and claim 10 is clearly patentably distinct, one consists only of silica gel, the other adds a second silica species thereto.

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species, from (A) or (B) even though this requirement is traversed. If this application is filed under Rule 371, the legal authority is PCT Rule 13.2, Annex B, Part 1 (f) "Markush Practice"; PCT Rule 13 and 35 U.S.C. § 372, rather than 35 U.S.C. § 121.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under U.S.C. § 103 (of) the other invention.

Art Unit: 1614

Election of species is required per MPEP § 803, 809.02 (d) (Markush group claim practice, separate and burdensome fields of search required).

Patentably distinct Markush species are independent inventions, In re Webber, 198 USPQ 328, In re Haas, 198 USPQ 334. Divisional applications may be filed under 35 U.S.C. § 121, as a result of an Office requirement for an election of a patentably distinct species as made herein. In re Joyce, 115 USPQ 412, In re Herrick, 115 USPQ 412. This satisfies the "patentably distinct" criterion since the Examiner is not of the opinion that the various species are obviously unpatentable over one another, and each species (as noted above) is capable of independent manufacture, use and sale, with the other components of the claimed formulations.

Applicant is further required to identify the claims that correspond to the elections as well as those that do not even if the requirements are traversed.

Applicants have submitted an IDS that has an item, WO 99/51196, (10/99) Thomas et al W.R. GRACE, priority data 09/056688 that appears to be material relevant and important to the issue of patentability of the elected claims. Are there any commonly assigned U.S. applications and/or patents corresponding thereto? (none are on the IDS submission).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shep Rose whose telephone number is (703) 308-4609. The examiner can normally be reached on Monday, Tuesday and Thursday from 6 AM to 3:30 PM.

Art Unit: 1614

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel can be reached on (703) 308-4725. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.



**SHEP K. ROSE  
PRIMARY EXAMINER**

Rose/LR  
June 26, 2003